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In re Application of
JOUISHOMME, Herve, et al.

Application No.: 09/980,080

PCT No.: PCT/CA00/00650

Int. Filing Date: 02 June 2000

Priority Date: 03 June 1999

Attorney Docket No.: PGI-1

For: 3-DIMENSIONAL IN VITRO MODELS
OF MAMMALIAN TISSUES

DECISION ON

PETITION UNDER

37 CFR 1.47(a)

This is a decision on applicants' petition filed in the United States Patent and Trademark Office (USPTO) on 20 May 2002. The petition has been treated as a petition under 37 CFR 1.47(a).

BACKGROUND

On 02 June 2000, applicants filed international application PCT/CA00/00650, which claimed a priority date of 03 June 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 14 December 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 12 December 2000, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 03 December 2001.

On 30 November 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 18 January 2002, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 20 May 2002, applicants submitted the instant petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*, a combined declaration and power of attorney executed, a petition for a two month extension of time and the fee for a two month extension of time.

DISCUSSION

When a joint inventor cannot be located or refuses to sign the oath or declaration, a petition under 37 CFR 1.47(a) must accompany the oath or declaration. 37 CFR 1.47(a). A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant.

Item (1) has been met. The petition fee of \$130 has been paid.

As to item (2), it is unclear whether applicants are asserting that the non-signing inventor has refused to sign or whether applicants have been unable to locate the non-signing inventor after a diligent effort. In either situation, applicants are required to supply proof of pertinent facts. 37 CFR 1.47(a). Applicants have not supplied any proof.

It is noted that if this petition is based on the refusal of the inventor to sign the declaration, applicants must demonstrate that a *bona fide* attempt was made to present a copy of the application papers to the inventor. MPEP 409.03(d).

If applicants were unable to locate the inventor after a diligent effort, "a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made." MPEP §409.03(d). "The statement must be signed where at all possible by a person having firsthand knowledge of the facts recited therein." MPEP §409.03(d). Copies of documentary evidence should be submitted. MPEP §409.03(d).

As to item (3), the petition does not state the last known mailing address of nonsigning inventor Herve Jouishomme.

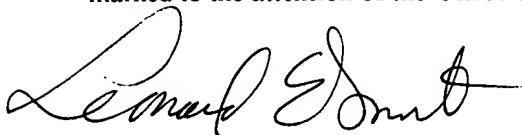
As to item (4), the declaration does not comply with 37 CFR 1.47(a). The declaration must be executed by the joint inventors on behalf of the nonsigning inventor. The present declaration is executed by a patent agent on behalf of the nonsigning inventor. A new oath or declaration in compliance with 37 CFR 1.47 and 37 CFR 1.497 is required. Additionally, it is noted that the declaration appears to have been modified subsequent to its execution by the inventors, namely the page numbers have been modified. "The wording of an oath or declaration cannot be amended, altered or changed in any manner after it has been signed." MPEP §602.01. See MPEP §605.04(a).

CONCLUSION

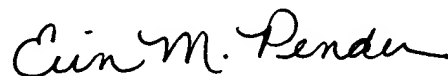
For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.



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